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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/628,112 07/27/00 LEE

S JHU1120-11

EXAMINER

HM22/0712

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ANDRES, I

ART UNIT

PAPER NUMBER

1646

DATE MAILED:

07/12/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

**Office Action Summary**

Application No.

09/628,112

Applicant(s)

LEE ET AL.

Examiner

Janet L Andres

Art Unit

1646

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claims 1-33 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

**Attachment(s)**

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Election/Restrictions*

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-18, drawn to polypeptides, classified in class 530, subclass 350.
- II. Claims 19 and 20, drawn to polypeptide mutants, classified in class 530, subclass 350.
- III. Claims 21-24, drawn to polynucleotides, classified in class 435, subclass 69.1.
- IV. Claims 25 and 26, drawn to transgenic animals, classified in class 800, subclass 9.
- V. Claims 27 and 28, drawn to antibodies, classified in class 530, subclass 388.1 and 389.1.
- VI. Claims 29 and 30, drawn to virtual representations, classified in class 707, subclass 100.
- VII. Claims 31-33, drawn to a method of identifying functional peptides, classified in class 435, subclass 7.1.

The inventions are distinct, each from the other because of the following reasons:

The polypeptides of Invention I are distinct from the mutants of Invention II because they have different characteristics, different structural and functional properties, and different uses.

The polypeptides of Invention I are not related to the polynucleotides of Invention III, the animals of Invention IV, the antibodies of Invention V, or the virtual representations of Invention VI. They differ structurally and functionally, can not be used together or interchangeably, and have non-coextensive searches and considerations.

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The polypeptides of Invention I are distinct from the methods of Invention VIII because the polypeptide Invention includes molecules that can not be identified by these methods and because the polypeptides can be identified in other ways, such as functional assays.

The mutants of Invention II are not related to the polynucleotides of Invention III, the animals of Invention IV, the antibodies of Invention V, or the virtual representations of Invention VI. They differ structurally and functionally, can not be used together or interchangeably, and have non-coextensive searches and considerations.

The mutants of Invention II are distinct from the methods of Invention VI because they can be identified in other ways, such as functional assays.

The polynucleotides of Invention III are not related to the animals of Invention IV, the antibodies of Invention V, or the virtual representations of Invention VI. They differ structurally and functionally, can not be used together or interchangeably, and have non-coextensive searches and considerations.

The polynucleotides of Invention III are not related to the methods of Invention VI. They can not be used in or identified by these methods.

The transgenic animals of Invention IV are not related to the antibodies of Invention V or the virtual representations of Invention VI. They differ structurally and functionally, can not be used together or interchangeably, and have non-coextensive searches and considerations.

The transgenic animals of Invention IV are not related to the methods of Invention VII. They can not be used in or identified by these methods.

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The antibodies of Invention V are not related to the virtual representations of Invention VI. They differ structurally and functionally, can not be used together or interchangeably, and have non-coextensive searches and considerations.

The antibodies of Invention V are not related to the methods of Invention VII. They can not be used in or identified by these methods.

The virtual representations of Invention VI are not related to the methods of Invention VII. They can not be used in or identified by these methods.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the searches required for the different groups are different, restriction for examination purposes as indicated is proper.

This application contains claims directed to the following patentably distinct species of the claimed invention:

For Groups I and II, the species are:

SEQ ID Nos: 2, 4, 6, 8, 10, 12, 14, 16, 18, 20, 27, 29.

These sequences each represent polypeptides with distinct structural and functional characteristics. Identification of one would not render another obvious. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1, 8, 9, 10-12, and 14-20 are generic.

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Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janet Andres, Ph.D., whose telephone number is (703) 305-0557. The examiner can normally be reached on Monday through Friday from 8:00 am to 5:30 pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler, Ph.D., can be reached at (703) 308-6564. The fax phone number for this group is (703) 305-3014 or (703) 308-4242.

Communications via internet mail regarding this application, other than those under U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [yvonne.eyler@uspto.gov].

All Internet email communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark Office on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Janet Andres, Ph.D.  
July 3, 2001

  
YVONNE EYLER, PH.D.  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1800